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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,690	04/03/2000	Raphael Duval	PET-1638-D1	4031
23599	7590	06/30/2004	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			KRISHNAN, GANAPATHY	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

09/541,690

## Applicant(s)

DUVAL ET AL.

## Examiner

Ganapathy Krishnan

## Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21, 60, 61, 65, 69-72, 75 and 76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 60-61, 65, 69-72, 75 and 76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

The amendment filed March 23, 2004 has been received, entered and carefully considered. The following information provided in the amendment affects the instant application:

1. Claims 60, 69 and 70 have been amended.
2. Remarks drawn to rejections under 35 USC 112, second paragraph and 102.

Claims 21, 60-61, 65, 69-72, 75 and 76 are pending in the case. Applicants elected claims 21, 60-61, 65, 69-72, 75 and 76 for prosecution. See interview summary (paper # 19) mailed with office action dated 6/02/2003.

The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

The objection to claim 60 has been overcome by amendment.

### ***Claim Rejections - 35 USC § 112***

The 35 USC 112 second paragraph rejection of claims 61 and 69 have been overcome in view of applicants' remarks. The rejection of claims 21, 60, 65, 70, 75 and 76 are maintained for reasons of record.

Claim 60 has been amended to recite that Q is a group which is reactive towards a hydrogen carried by a heteroatoms selected from the group consisting of oxygen, nitrogen and sulphur or a precursor of such a group. This is interpreted to mean that Q is any group that abstracts hydrogen from an OH or NH or SH. Not every group can

abstract a hydrogen. The group Q has to be defined further. Moreover, the claim further recites, "or a precursor of such a group". It is not clear if the term "group" at the end of the recitation refers to the group Q or to the group consisting of oxygen, nitrogen and sulphur. It is not clear what the precursors are without knowing what all are encompassed by the group Q or by the group consisting of oxygen, nitrogen and sulphur.

Regarding claim 65 applicants argue that the precursor of formula III is the compound having the formula set on page 5 of the listing of claims filed on September 2, 2003 and have given a structure at page 29 of the Remarks of March 23, 2004. The structure for the precursor of formula III given at page 29 of the Remarks of March 23, 2004 is not seen in the claims listing filed on September 2, 2003 (September 4, 2003 in our records). However, if the structure that is shown at page 29 in the Remarks of March 23, 2004 is the precursor of formula III then this structure should be recited in claim 64 from which claim 65 depends. Claim 64 does not recite this structure but recites precursor of formula III. Moreover, the structure shown for precursor of formula III in the remarks of March 23, 2004 is defined as LINK A in claims 61 and 65. A single structure is defined as LINK A and precursor of formula III. The claim is not clear.

Claim 70 has been amended to recite also comprising a function selected from the group consisting of. It is still not clear what this means.

Claim 75 recites Q is selected from the group formed by one of the following groups and recites  $-N-(C=O)$  or a precursor thereof;  $-COCl$  or its precursor and  $-N-(C=S)$ . This recitation is not clear. It is not clear what groups are encompassed by this recitation. The claim as recited includes any group formed by the partial structures  $-N-(C=O)$ ,  $-N(C=S)$  and  $COCl$ .

The rejection of Claims 21, 60-61, 65, 69-72, 75 and 76 under 35 USC 112, second paragraph is maintained. Claims that depend from rejected base claims that are unclear/indefinite are also rendered unclear/indefinite.

***Claim Rejections - 35 USC § 102***

The rejections of claims 21, 60, 61, 65 and 70-72 have been overcome in view of applicants' arguments.

***Conclusion***

Claims 21, 60-61, 65, 69-72, 75 and 76 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Art Unit: 1623

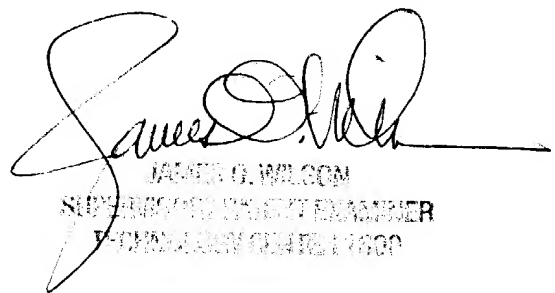
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathy Krishnan whose telephone number is 571-272-0654. The examiner can normally be reached on 8.30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GK



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